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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,594	02/05/2002	Thomas Falone	INNERCORE-4	5901

3624 7590 10/19/2004

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EXAMINER	
GRAHAM, MARK S	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/067,594	FALONE ET AL.	
	Examiner	Art Unit	
	Mark S. Graham	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *32-57* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *32-57* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/2, 6/11/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 51, 52, and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Falone et al. '643 (Falone). The layer to the inside of fiberglass layer 28 is the inner layer and the layer to the outside of layer 28 is the outermost layer.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 32-34, 41, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of Falone. Kramer discloses the claimed grip structure with the exception of the inner details of the grip. However, as disclosed by Falone it is known in the art to use an inner laminate structure such as that claimed. It would have been obvious to one of ordinary skill in the art to have used such to form Kramer's grip as well to help dissipate vibration.

Regarding claim 41, Kramer shows a cylindrical handle. However, the examiner takes official notice that tapered handles are known in the art as well. It would have been obvious to one of ordinary skill in the art to have tapered Kramer's grip as well if it was desired to use it on a tapered grip bat.

Claims 32 and 35-37 rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Falone. Wilson discloses the claimed grip structure with the exception of the inner

details of the grip. However, as disclosed by Falone it is known in the art to use an inner laminate structure such as that claimed. It would have been obvious to one of ordinary skill in the art to have used such to form Wilson's grip as well to help dissipate vibration.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,652,398 in view of Falone. The '398 patent claims the claimed device with the exception of the type of material used as the type of fiber material used. However, as disclosed by Falone fiberglass may be used as the middle layer material. It would have been obvious to one of ordinary skill in the art to have used such as the fiber material in the '398 claims as well if such gave the user preferred use characteristics.

Claims 52-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,652,398. Removal of the additionally claimed elements with their corresponding loss of function would have been obvious to one ordinary skill in the art.

Claims 32 and 35-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-21 of copending Application No. 10/659,790; claims 19-25 of copending Application No. 10/659,674; claims 9-14 of copending Application No. 10/659,690; and claims 3-8 of copending Application No. 10/659,560 each in view of Wilson.

Each of these applications claims the claimed vibration dissipating structure with the exception of the structural details for use on a bat. However, as disclosed by Wilson it is known in the art to form such structures for use on a bat. It would have been obvious to one of ordinary skill in the art to have formed the vibration dissipating materials of the application claims as well to help dissipate vibration.

Claims 32 and 35-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-21 of copending Application No. 10/659,790; claims 19-25 of copending Application No. 10/659,674; claims 9-14 of copending Application No. 10/659,690; and claims 3-8 of copending Application No. 10/659,560 each in view of Kramer.

Each of these applications claims the claimed vibration dissipating structure with the exception of the structural details for use on a bat. However, as disclosed by Kramer it is known in the art to form such structures for use on a bat. It would have been obvious to one of ordinary skill in the art to have formed the vibration dissipating materials of the application claims as well to help dissipate vibration.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 47-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-21 of copending Application No. 10/659,790; claims 19-25 of copending Application No. 10/659,674; claims 9-14 of copending Application No. 10/659,690; and claims 3-8 of copending Application No. 10/659,560 each in view of Falone. The claims of each application claim the claimed device with the exception of the type of material used as the type of fiber material used. However, as disclosed by Falone fiberglass may be used as the middle layer material. It would have been obvious to one of ordinary skill in the art to have used such as the fiber material in the '398 claims as well if such gave the user preferred use characteristics.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 52-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-21 of copending Application No. 10/659,790; claims 19-25 of copending Application No. 10/659,674; claims 9-14 of copending Application No. 10/659,690; and claims 3-8 of copending Application No. 10/659,560. Removal of the additionally claimed elements with their corresponding loss of function would have been obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

MSG
10/12/04

Mark S. Graham
Primary Examiner